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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,778	02/15/2001	Tsui-Tuan Fan Wong	CFP-11803	3037

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EXAMINER

PATEL, TULSIDAS C

ART UNIT	PAPER NUMBER
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2839

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,778

Applicant(s)

FAN WONG, TSUI-TUAN

Examiner

T. C. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/6/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Decision on Petition

General Status

1. This is a Final Action on the Merits. Claims 1 and 3-12 are pending in the case, claims 13-29 are cancelled.
2. The request for suspension of prosecution is hereby denied (see attachment). It is noted that claims 13-20 for provoking interference (copied from Prazoff US 6,379,190 in amendment B, paper 9, dated 6-17-2002) are now cancelled by the last amendment (paper 18 dated 10/6/2003).

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the two extended prongs of second adapter receivable in the plated through holes of the first adapter, as required by claim 1, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

There is no figure, which shows that the collar 3 is positioned over a first adapter flange portion 121 so as to be connected to a second light or enclosure. An additional figure may be provided to show the proper connection between various parts.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. Claims 1, 3-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the first end of the enclosure" in line 8' "the second end of the enclosure" in lines 12-13 and "the first adapter member" in line 14. There is insufficient antecedent basis for these limitations in the claim.

Claim 1, lines 18-19, it is not clear what is meant by "by inserting the two second pins ... into the plated holes of the first adapter". According to the disclosure the two second pins 211 of the second adapter 2 are inserted into the enclosure 10; it is the prongs 212 that are inserted into the two plated holes 112 of the first adapter 1, hence the recitation is confusing.

It is noted that the first and second decorative lights, each are provided with an enclosure and therefore, the recitation of "the enclosure" in lines 6, 8, should be referenced as 'the enclosure for the first decorative light' and that on lines 11 and 13 should be referenced as 'the enclosure for the second decorative light', so as to distinguish between the two separate enclosures.

Only few of the deficiencies have been pointed out above, the Applicant is required to review all the claims and make necessary corrections.

Claim Objections

5. Claims 4, 7, 8, 11 and 12 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 3, 5, 6, 9 and 10. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in

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wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 4 recites the limitation, which is identical to the limitation of claim 3 and both depends from claim 1.

Claim 7 recites the limitation, which is identical to the limitation of claim 5 and both depend from claim 1.

Claim 8 (claims 1+7+8) recites the limitation, which is identical to the limitation of claim 6 (claims 1+5+6).

Claim 11 (claims 1+4+11) recites the limitation, which is identical to the limitation of claim 9 (claims 1+3+9), and

Claim 12 (claims (1+4+11+12) recites the limitation which is identical to the limitation of claim 10 (claims 1+3+9+10).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 3-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin (US 4,607,317).

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Lin, in figures 1-6, discloses a connector for connecting two decorative lights encased in a transparent enclosures, the connector comprising a first adapter 24, 25, 26, 27 adapted to be engaged with a first end of the enclosure 10a, a combination male-female connector 24, provided with two first pins 242, adapted to be electrically connected with multiple light sources inside the enclosure 10a, and two plated through holes 241, and a resilient cover 25 outside a joint between the combination male-female connector and the first end of the enclosure. A second adapter 21, 22, 23, adapted to be engaged with a second end of enclosure 10b, having male connector 21 provided with two second pins 211, 212, two extended prongs 242, the two prongs being selectively receivable in plated through holes 241 and a second cover 23 formed on a joint between the male connector 21 and a second end of enclosure 10b. A collar 27 is also disclosed, which is slidably mounted around the first adapter 24, and having a through hole to allow extension of second cover 232, threads of collar 27 fits over threads 232, when assembled, whereby length of the decorative light 10a can be extended by connection with a second light fitted 10b with a second cover 23.

In so far as recitation of 'covers being injection molded' is concerned, though the reference does not specifically state the covers made by injection molding, it is obvious to make PVC articles by injection molding, as it is well known in the art to make such article by injection molding.

For claims 3, 4, 5, 6, 7, and 8-12, the collar is disclosed in figure 3 and plug 60 with a blind hole is connected to enclosure 10b. Although the threaded part is not shown, in order to couple the plug on end of the enclosure, it will require threads (similar to shown in enclosure 1a).

Response to Arguments

8. Applicant's arguments with respect to claims 1, 3-12, have been considered but are not persuasive.

The applicant has amended the drawings, which are now approved by the Examiner, however, none of the drawing show the collar 3 is positioned over a first adapter flange portion 121 so as to be connected to a second light or enclosure.

The amendment to claim 1 has created numerous 35 USC 112, second paragraph rejections, and also provisional double patenting rejection, the details of which are given above. The Applicant has also argued that "the Lin reference does not teach the limitation "a resilient first cover formed by injection molding outside a joint between the combination male-female connector and the first end of the enclosure". The Examiner wishes to point out that the claim 1 does not positively recite the enclosure for the first decorative light and also that the figure 1 of the Lin discloses resilient cover 25 over the joint male-female connector and the enclosure for the first decorative light 10a. It is also noted that it is only the cover of the adapter that is formed by injection molding, which is already addressed above (the Applicant is reminded that the enclosure of the first decorative light is not positively recited, as the invention is directed to the connector and not the assembly of the connector and the decorative light enclosure).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. C. Patel whose telephone number is (571) 272-2098. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on (571) 271-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



T. C. Patel
Primary Examiner
Art Unit 2839

Tcp
June 1, 2004